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OFFICE OF PETITIONS

In re Application of
Ervin Goldfain et al
Application No. 09/862,636
Filed: May 22, 2001
Attorney Docket No. 281-329.02

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:DECISION DISMISSING PETITION
:UNDER 37 CFR 1.137(f)
:
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This is a decision on the petition under 37 CFR 1.137(f),¹ filed January 25, 2002,² to revive the above-identified application.

The petition is **dismissed** as inappropriate for the reasons stated below.

The record discloses that, on May 22, 2001, the date of filing of the instant application, a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was filed certifying that "the invention disclosed in this **application has not been and will not be** the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing."

Petitioner now requests under 35 U.S.C. § 122(b)(2)(B)(ii) that the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) be rescinded and the application revived because this application became abandoned for failure to notify the Office

¹ 37 CFR 1.137(f) provides for revival of a nonprovisional application which became abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing.

² The existence of the instant petition was only recently brought to the attention of the deciding official's office. The Office sincerely apologizes for the delay in replying to the instant petition and any inconvenience caused petitioner by this delay.

of the filing of an international or foreign application within 45 days of the filing thereof. In this regard, petitioner states that an international or foreign application was filed on May 22, 2001, the same date as the filing date of the instant application.

The instant nonprovisional application did not become abandoned as a result of the filing of a "corresponding" application filed in another country, or under a multilateral international agreement, **subsequent** to the filing of the present application. In this regard, 35 U.S.C. § 122(b)(2)(B)(iii) states:

An applicant who has made a request under clause (i) but who **subsequently files, in a foreign country or under a multilateral international agreement** specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days **after the date of the filing of such foreign or international application**. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional [emphasis supplied].

The facts of this case are that the subject application was filed on May 22, 2001, and a corresponding foreign application was also filed on May 22, 2001. The statute does not provide for the situation where a certification under 35 U.S.C. § 122(b)(2)(B)(i) was made, despite the fact that an application was previously filed in another country or under the multilateral international agreement. In view of petitioner's statement that a foreign application was filed on May 22, 2001, the same date as the filing of the subject application, the filing of the foreign application cannot be considered to have been filed **subsequent** to the filing of the subject application in the United States. The statute at 35 U.S.C. § 122(b)(2)(B)(iii) only provides for revival in the situation where a certification was made under 35 U.S.C. § 122(b)(2)(B)(i) at the time of filing the application and an application was **subsequently** filed in a foreign country without notifying the Office within 45 days of the filing thereof.

Since the foreign or international application was either filed on the same date or filed prior to the filing date (this would be true if the corresponding foreign or international application has a filing date of May 21, 2001) as the subject application, this application did not become abandoned pursuant to the provisions

of 35 U.S.C. § 122(b)(2)(B)(iii). Therefore, a petition to revive pursuant to the provisions of 37 CFR 1.137(f) is inappropriate and, consequently, must be dismissed.

Petitioner further states:

* * * the Laws state that the Notice of Foreign Filing is to be made "to the Director [of Publication], while the Rules state that the Request is to be made to the "Office," which in the Rules refers to the Patent Office in General. Note therefore that under the Rules, the mere act of filing a PCT application in the U.S. Receiving Office (as in the PCT/US01/16557) could be considered sufficient notice of foreign filing to "the Office" under 37 CFR 1.213(c).

Petitioner's contentions are not well taken. In this regard, petitioner's attention is directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). However, in the instant situation, this is a moot issue since this application did not become abandoned for failure to notify the Office within 45 days subsequent to the filing of the foreign application, in that the instant application and the foreign application were filed on the same day, as discussed *supra*.

In reviewing PALM Intranet database computer records, it is noted that this application published as Publication No. US20020097379A1 on July 25, 2002.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. See 35 U.S.C. § 41(c)(7). Accordingly, as authorized, the required \$1,280 petition fee will be charged to Deposit Account No. 50-0289.

This application is being forwarded to Technology Center AU 3737 for examination in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

A handwritten signature in cursive script, reading "Frances Hicks".

Frances Hicks

Petitions Examiner

Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy